



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/884,012

06/18/2001

Roger Gustavsson

262/204

4613

7590

12/15/2004

DAVID E. BENNETT
COATS & BENNETT, P.L.L.C.
1400 CRESCENT GREEN, SUITE 300
CARY, NC 27511

EXAMINER

IQBAL, KHAWAR

ART UNIT

PAPER NUMBER

2686

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/884,012

Applicant(s)

GUSTAVSSON ET AL.

Examiner

Khawar Iqbal

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6,9-20,24-30,33-39,43-45,47-48,50-57,60-65,67-70 are rejected under 35 U.S.C. 102(b) as being unpatentable by Haartsen (5870673).

3. Regarding claim 1 Haartsen teaches a method of wireless communication employing a terminal configured for tuning to either a carrier of a best-effort network or a carrier of a multi-service network, the method comprising (figs. 1,7-9):

registering the terminal (12) with the multi-service network (10)(col.15, lines 26-50);

registering the terminal (12) with the best-effort network (10,24,12)(col. 13, lines 60-67, col.15, lines 26-50);

tuning the terminal to the best-effort carrier (col.15, lines 26-50, col.) 3, 56-67);

activating a do not disturb function (No operation) associated with the terminal (col.15, line 26-col. 16, line 27); and

de-registering the terminal from the multi-service network in response to the activation of the do not disturb function.

Regarding claims 2,11,27,36,43,50,56,65,69 Haartsen teaches before de-registering the terminal, tuning the terminal to the multi-service carrier; and after de-

Art Unit: 2686

registering the terminal, tuning the terminal to the best-effort carrier (col.15, line 26-col. 16, line 27).

Regarding claims 3,12,17,28,37,44,51,57,67,70 Haartsen teaches disabling the do not disturb function; tuning the terminal to the multi-service carrier in response to the disabling of the do not disturb function; and re-registering the terminal with the multi-service network (col.15, line 26-col. 16, line 27).

Regarding claims 4,13,18,29,38,45,52 Haartsen teaches while the terminal is tuned to the best-efforts carrier and is registered with the multi-service network, periodically tuning the terminal to the multi-service carrier to check for incoming communications from the multi-service network (col.15, line 26-col. 16, line 27).

Regarding claims 5,14,19,30,39,53 Haartsen teaches wherein activating the do not disturb function occurs automatically upon tuning the terminal to the best-effort carrier (col.15, line 26-col. 16, line 27).

Regarding claims 6,15,20,24,33,54 Haartsen teaches after de-registering the terminal, initiating a data communication over the best-effort network (col.15, line 26-col. 16, line 27).

Regarding claims 9,16,26,34,47,55,60-63 Haartsen teaches wherein activating the do not disturb function occurs automatically upon initiating the data communication (col.15, line 26-col. 16, line 27).

Regarding claim 10 Haartsen teaches a method of wireless communication employing a terminal configured for tuning to either a carrier of a best-effort network or a carrier of a multi-service network, the method comprising (figs. 1,7-9):

registering the terminal with the multi-service network (col.15, lines 26-50);
registering the terminal with the best-effort network (col. 13, lines 60-67,col.15, lines 26-50);
tuning the terminal to the best-effort carrier (col.15, lines 26-50, col. 13, 56-67);
activating a do not disturb function associated with the terminal (col.15, line 26-col. 16, line 27); and
in response to the activation of the do not disturb function, instructing the multi-service network to page the terminal regarding selected incoming communications (col.15, line 26-col. 16, line 27).

Regarding claim 25 Haartsen teaches a terminal for wireless communication, comprising (figs. 1,7-9):

a do not disturb function configured to be activated and de-activated (col.15, lines 26-50);

a transceiver configured to selectively tune to a carrier of a multi-service network or to a carrier of a best-effort network (col. 13, lines 60-67, col.15, lines 26-50); and

a processor configured to: tune the transceiver to the multi-service network, register with the multi-service network, tune the transceiver to the best-effort carrier (col.15, lines 26-50, col. 13, 56-67), register with the best-effort network, and de-registers with the multi-service network when the do not disturb function is activated (col.15, line 26-col. 16, line 27).

Regarding claim 35 Haartsen teaches a wireless communication network, comprising (figs. 1,7-9):

Art Unit: 2686

a multi-service network comprising a multi-service carrier (col.15, lines 26-50);
a best-effort network comprising a best-effort carrier (col. 13, lines 60-67, col.15, lines 26-50); and
a terminal comprising: a do not disturb function configured to be activated and de-activated (col.15, lines 26-50);
a transceiver configured to selectively tune to the multi-service carrier or to the best-efforts carrier (col.15, lines 26-50, col. 13, 56-67); and
a processor configured to: tune the transceiver to the multi-service carrier, register the terminal with the multi-service network (col.15, lines 26-50, col. 13, 56-67), tune the transceiver to the best-effort carrier, register the terminal with the best-effort network, and de-register the terminal from the multi-service network or instruct the multi-service network to page the terminal regarding selected incoming communications when the do not disturb function is activated (col.15, line 26-col. 16, line 27).

Regarding claim 48 Haartsen teaches a terminal for wireless communication, comprising (figs. 1,7-9):

a do not disturb function configured to be activated and de-activated (col.15, lines 26-50);

a transceiver configured to selectively tune to a carrier of a multi-service network or to a carrier of a best-effort network (col. 13, lines 60-67, col.15, lines 26-50); and

a processor configured to: tune the transceiver to the multi-service network, register with the multi-service network, tune the transceiver to the best-effort carrier

Art Unit: 2686

(col.15, lines 26-50), register the terminal with the best-effort network, and instruct the multi-service network to page the terminal regarding selected incoming communications when the do not disturb function is activated (col.15, line 26-col. 16, line 27).

Regarding claim 64 Haartsen teaches a terminal for wireless communication, comprising (figs. 1,7-9):

a do not disturb function configured to be activated and de-activated (col.15, lines 26-50);

a transceiver configured to selectively tune to a carrier of a multi-service network or to a carrier of a best-effort network (col. 13, lines 60-67, col.15, lines 26-50); and

a processor configured to: tune the transceiver to the multi-service network, register with the multi-service network, tune the transceiver to the best-effort carrier (col.15, lines 26-50, col. 13, 56-67), register the terminal with the best-effort network, and instruct the multi-service network to refrain from paging the terminal regarding all incoming communications if the do not disturb function is activated (col.15, line 26-col. 16, line 27).

Regarding claim 68 Haartsen teaches a method of wireless communication employing a terminal configured for tuning to either a carrier of a best-effort network or a carrier of a multi-service network, the method comprising (figs. 1,7-9):

registering the terminal with the multi-service network (col.15, lines 26-50);

registering the terminal with the best-effort network (col. 13, lines 60-67, col.15, lines 26-50);

tuning the terminal to the best-effort carrier (col.15, lines 26-50, col. 13, 56-67);
activating a do not disturb function associated with the terminal (col.15, line 26-
col. 16, line 27);
in response to the activation of do not disturb function, instructing the multi-service
network to refrain from paging the terminal regarding all incoming communications
(col.15, line 26-col. 16, line 27).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7,8,21-23,31,32,40-42,46,49,58 and 59,66 are rejected under 35
U.S.C. 103(a) as being unpatentable over Haartsen (5870673) and further in view of
Ahmad et al (20020082029).

Regarding claims 7,8,21-23,31,32,40-42,46,49,58 and 59,66 Haartsen SMS call
delivery can continue to be carried out through the wide area cellular network.
Therefore, mobile terminal maintains a dual monitor mode as it continues to be
registered with the wide area cellular network for SMS delivery. Outgoing calls from
mobile terminal may, optionally, be preferentially routed through private radio
communications network to obtain the benefits. Haartsen does not specifically teach

wherein the data communication is a packet data communication and the packet data communication includes a voice over IP communication, instructing the multi-service network to forward unselected incoming communications to a voice mail account.

In an analogous art, Ahmad et al teaches wherein the data communication is a packet data communication and the packet data communication includes a voice over IP communication, instructing the multi-service network to forward unselected incoming communications to a voice mail account (page 1, paragraphs # 0010,0022 and 0038). A network controller and a base station controller are formed to define an interface there between them that enables the two systems to facilitate and respond to a voice call that is to be set up to a hybrid mobile station even though the hybrid mobile station is presently engaged in a data only call. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Haartsen base station either pages the mobile station to establish the voice call, forwards the call to voice mail, or forwards the call either to an Internet Call Delivery Server or to an Internet Call-Waiting Server.

Response to Arguments

Applicant's arguments filed 8-25-04 have been fully considered but they are not persuasive. Examiner has thoroughly reviewed applicant's arguments but firmly believes the cited reference to reasonably and properly meets the claimed limitations. Applicant's argument was that "Haaartsen fails to disclose a best efforts network". In response, examiner would like to point out that Haaartsen teaches, the method involves monitoring paging messages from a wide area cellular network at a first predetermined

time interval corresponding to the paging channel of the network. Beacon transmissions from the private radio communications network are monitored at a second predetermined time interval corresponding to the beacon channel of private radio communications network. When the first predetermined time interval and the second predetermined time interval conflict it is selected between the monitoring for paging messages and monitoring for beacon transmission. When a paging message is received the wide area cellular network is accessed indicating receipt of an incoming call on the wide area cellular network. When a beacon transmission is received the private radio communications network is accessed indicating receipt of an incoming call on the private radio communications network. A mobile terminal in range of a private communications network typically preferably enters a private mode attaching to the private communications network to enjoy benefits such as lower tariffs, longer talk and stand-by time, and better voice quality (col. 3, lines 35-40). When the first predetermined time corresponding to the paging channel and the second predetermined time corresponding to the beacon channel conflict, the mobile terminal selects between monitoring for paging messages and monitoring for beacon transmissions (col. 5, lines 20-24). Monitoring for beacon transmissions could be given preference when the predetermined time intervals for the paging channel and beacon channel conflict (col. 13, lines 64-67). Outgoing calls from mobile terminal 30 may, optionally, be preferentially directed through private radio communications network 12 to obtain the benefits (col. 15, lines 45-50). Additionally, the examiner has given the claim language its broadest reasonable interpretation. Although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Anticipatory reference need not duplicate, word for word, what is in claims; anticipation can occur when claimed limitation is "inherent" or otherwise implicit in relevant reference (Standard Havens products Incorporated v. Gencor Industries Incorporated, 21 USPQ2d 1321).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **KHAWAR IQBAL** whose telephone number is 703-306-3015.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **BANKS-HAROLD, MARSHA**, can be reached at 703-305-4379.

Art Unit: 2686

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

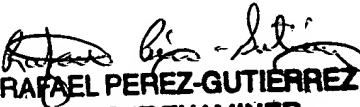
or faxed to:

(703) 872-9314 (for Technology Center 2684 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Khawar Iqbal


RAFAEL PEREZ-GUTIERREZ
PATENT EXAMINER
12/9/04